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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,173	03/09/2001	Chong Seng Cheng	1601457-0004	9334

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WHITE & CASE LLP  
PATENT DEPARTMENT  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER
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BANSAL, GURTEJ

ART UNIT	PAPER NUMBER
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2189

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10/05/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/803,173	<b>Applicant(s)</b> CHENG, CHONG SENG	
	<b>Examiner</b> GURTEJ BANSAL	<b>Art Unit</b> 2189	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 22-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/03/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Remarks***

Applicants have amended claims 22, 29, 30 and canceled claim 25 in response to a Request for Rehearing Dated May 24, 2010.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22 and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9, 14, and 19 and also over 12, 17, and 22 respectively of copending Application No. 11/928,009.

Claims 29 and 30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9, 15, and 21 also over 14, 20, and 26 respectively of copending Application No. 11/926,505.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 22 is provisionally rejected over claims 9, 14, and 19 of 11/928,009.

While claim 19 does teach an interface, claims 9 and 14 of Application 11/928,009 does not explicitly teach an interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug;

However, it was Common Knowledge at the time of the invention to have an interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug.

It would have been obvious at the time of the invention to have combined the interface of Common Knowledge with the portable data storage device of 11/928,009 because it would allow for two systems to communicate with one another.

Claim 24 is provisionally rejected over claims 12, 17, and 22 of 11/928,009.

Claim 29 is provisionally rejected over claims 9, 15, and 21 of 11/926,505.

While claim 21 does teach an interface, claims 9 and 15 of Application 11/926,505 does not explicitly teach an interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug;

However, it was Common Knowledge at the time of the invention to have an interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug.

It would have been obvious at the time of the invention to have combined the interface of Common Knowledge with the portable data storage device of 11/926,505 because it would allow for two systems to communicate with one another.

Claim 30 is provisionally rejected over claims 14, 20, and 26 of 11/926,505.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112 (First Paragraph)***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "... having a memory space at least as large as the memory space of the magnetic disk or CD." The specification fails to indicate a minimum capacity of memory space within the device or even relate the amount of memory space in the portable USB device to the amount of memory which would be in a magnetic disk or a CD (Please refer to page 8, lines 18-21, of the decision by the Board of Appeals and Interferences dated 11/20/2009 where it is set forth that "[if] claim 22 were to specify that the 'capacity' refers to some minimum amount of memory by a number such as 1.44Mb, we would tend to agree with the Examiner that the subject matter is not supported by the disclosure").

***Claim Rejections - 35 USC § 112 (Second Paragraph)***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, applicant compares the size of the memory to a magnetic disk or a CD. However, the amount of memory a CD or a magnetic disk does not particularly point out or distinctly claim the subject matter which applicant regards as his invention because

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the size of these devices could vary. The limitation "... to serve as an alternative to a magnetic disk or CD", does not further help to define the size of a magnetic disk or CD because a storage medium of even a single bit, byte or etc. can be used to serve as an alternative to a magnetic disk or CD (See Decision on Request for Rehearing dated May 24, 2010 pages 2-4). Therefore, the size of memory of a magnetic disk or CD could vary greatly.

Secondly, applicant states "... capable of storing software for installation to the computer or of receiving and storing..." This does clearly articulate whether the invention actually does this or is simply capable of doing this. In being capable of storing software, it does not necessarily mean that the memory device actually does store software, it simply means it has the ability to do so. Under the broadest reasonable interpretation, by having memory in the device would enable a device to be capable of storing software.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Margalit et al. (US 6,748,541) (herein after Margalit).

As per claim 22., Margalit teaches a unitary portable data storage device (fig. 1, 10) which can be directly plugged into a universal serial bus (USB) socket of a computer (col. 5, lines 27-30) and which is operative to function as an alternative to a magnetic disk or compact disk (CD) (col. 7, lines 12-16), and which is capable of storing software for installation to the computer or of receiving and storing user's data present in the computer (col. 7, lines 12-16), the unitary portable data storage device comprising:

a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer (col. 5, lines 27-30);

an interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug (col. 4, lines 42-49);

a non-volatile solid-state memory, said memory being non-removable from the unitary portable data storage device and having a memory space at least as large as the memory space of a magnetic disk or CD to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (col. 4, lines 38-41, See Board of Appeals and Interferences decision dated 11/20/2010 which on page 8 states "we do not see why the capacity, if interpreted to refer to an amount of memory, requires more than a single byte (or bit) of memory and furthermore on page 16 of the decision the Board continues to state "Margalit also teaches that the plug device can store confidential medical information. *Id.* at col. 7, 11.13-16. The reference thus discloses, or at least suggests, a memory storage capacity sufficient to meet the (unspecified) amount of storage capacity asserted by Appellant."); and



a memory controller, the memory controller being coupled between the interface and the memory to control storage of data received via the USB plug in the memory in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (As illustrated in fig. 1, with CPU being between the interface and userdata memory), the data including at least user data that is not authorization data (col. 7, lines 12-16).

As per claim 23, Margalit teaches wherein the memory controller is non-removable from the unitary portable data storage device (As illustrated in col. 6, line 61 – col. 7, line 4 illustrates a non-removable memory controller within the definition of non-removable as defined and described in applicant's remarks and arguments dated 03/21/2005).

As per claim 24, Margalit teaches wherein the non-volatile solid-state memory is a flash memory (col. 4, lines 38-42).

As per claim 26, Margalit teaches wherein the memory controller comprises a micro-controller (col. 4, lines 23-26).

As per claim 27, Margalit teaches wherein the micro-controller includes a read-only memory which stores a program to control the operation of the micro-controller (col. 4, lines 35-37 and col. 10, lines 46-50).

As per claim 28, Margalit teaches wherein the unitary portable data storage device is sufficiently compact to maximize portability (col. 5, lines 63-65).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit as applied to claim 22 above, and further in view of Jha.

As per claim 29, Margalit teaches all the limitations of claim 22 as described above and further teaches wherein the non-volatile solid state memory is accessible via the USB plug (as illustrated in fig. 1).

Margalit does not explicitly teach wherein the non-volatile solid-state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection.

However, Jha teaches wherein the non-volatile solid-state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection (As illustrated in fig. 4 and further described in col. 10, line 60 – col. 11, line 17)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to use the zoned password protection of Jha with the flash memory device of Margalit in order to prevent inadvertent erasures or reprogramming of portions of the flash memory (col. 11, lines 17-19).

As per claim 30, the combination of Margalit and Jha teaches wherein one or more of said plurality of zones require a unique password (Jha, fig. 4) received via the USB plug for access (Margalit, col. 5, lines 20-30 describes wherein information is transmitted to the device via the USB plug).

### ***Response to Arguments***

Applicant's arguments filed 07/26/2010 have been fully considered but they are not persuasive.

Firstly, Applicant argues neither Margalit nor Jha discloses "a data storage device with a memory having a memory size at least as large as the memory size of a magnetic disk or CD." Applicant argues by support of an affidavit that the size of a magnetic disk at the time of the invention was at least approximately 1 megabyte. Firstly, as discussed in the Decision on Request for Rehearing the specification does not support a finding for a capacity for the memory device in question. Applicant attempts to relate the memory space capacity of the USB memory device to the storage capacity of a magnetic disk or CD, however, a magnetic disk and CD are only referred to on page 1, lines 14-15 of applicant's specification, and the context of the sentence at page 1, lines 14-15 is not directed to the Applicant's claim limitation of a memory device having a memory space capacity "at least as large as the memory spaces of a magnetic disk or CD". As indicated in the Decision from the Board of Appeals and Interferences (dated 11/20/2009) the device in Margalit discloses, or at least suggests, a memory storage sufficient to meet the amount of storage asserted by applicant and if applicant

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meant for this capacity to be a minimum amount of capacity this would not be supported by the specification (see pages 8 and 16 of the decision dated 11/20/2009).

Applicant next argues Jha does not disclose the limitation, "the non-volatile solid state memory is divided into a plurality of zones, each of the plurality of zones being selectively accessible in response to a zone selection received via the USB plug". However, the combination of Jha and Margalit does teach the following limitations because as described above, the non-volatile memory device is accessed via the USB plug as described by Margalit and Jha teaches dividing the non-volatile memory device into zones and addressing these zones using addresses. The combination of these two references together does teach the claimed limitation.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GURTEJ BANSAL whose telephone number is (571)270-5588. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reginald Bragdon can be reached on (571)272-4202. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GB/

/Reginald G. Bragdon/  
Supervisory Patent Examiner, Art Unit 2189